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Preparing for the Unitary Patent and the Unified Patent Court

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1. Introduction

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EPC – an incomplete patent system

EPC provides **not** for a **complete patent system** for a **single patent** in Europe:

- **European patents** (EP patents) granted by the EPO are **not** themselves enforceable
- Further step of **validation** in **designated** member states needed to get enforceable corresponding national patents.
- **Bundle of national patents** registered by **designation** and **validation** of the EP patent.
- **Lack of centralized court system** for European patents as **enforcement** and **invalidation** of EP patents is **on a strict national basis**

1. Introduction

Shortcomings of the bundle structure

- **High costs** for **obtaining** broad patent protection in Europe (mainly translation costs)
- **High costs** for **enforcement** due to **multi-jurisdictional litigation**
- **Legal uncertainty** due to **different decisions** and **varying timing** of court proceedings in the different national courts



1. Introduction

Solution

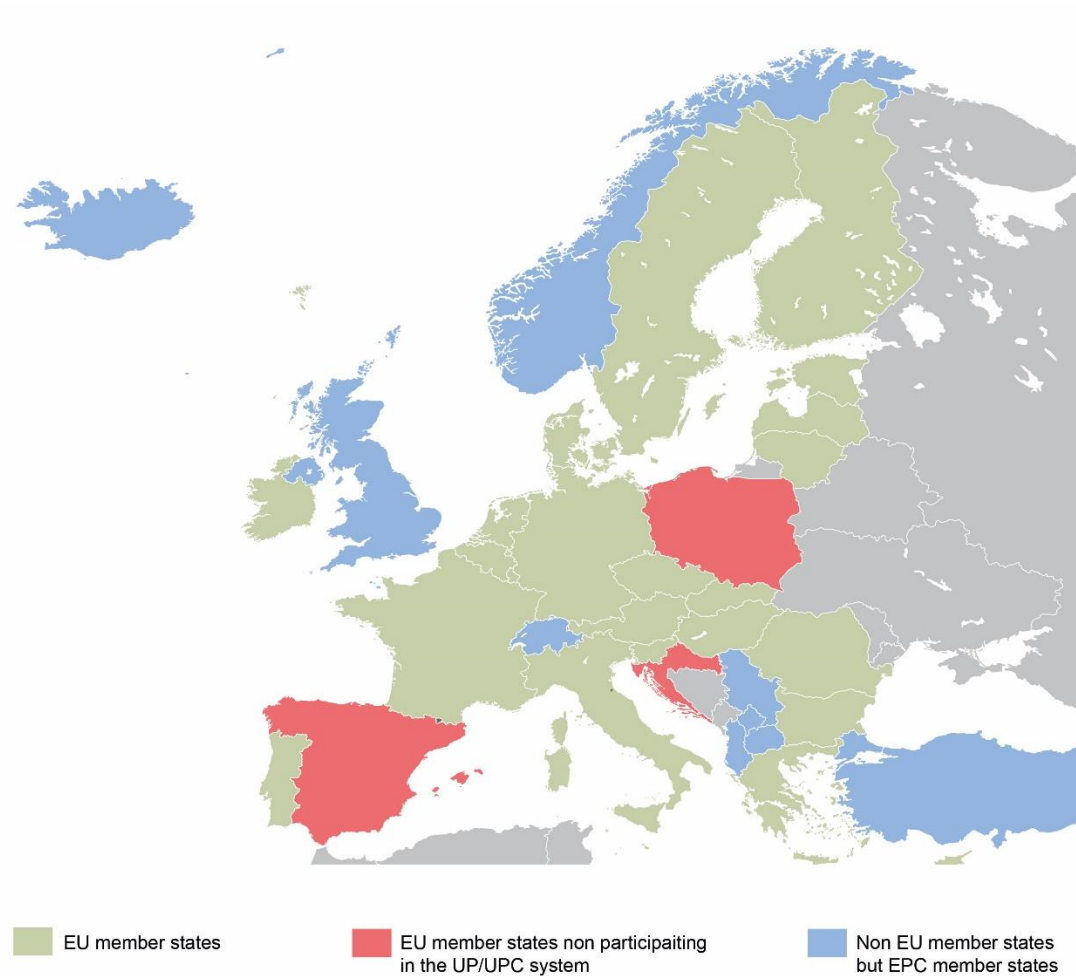
- *EP patent with unitary effect* (so-called Unitary Patent)
- *Unified Patent Court*



2. Unitary Patent (UP)

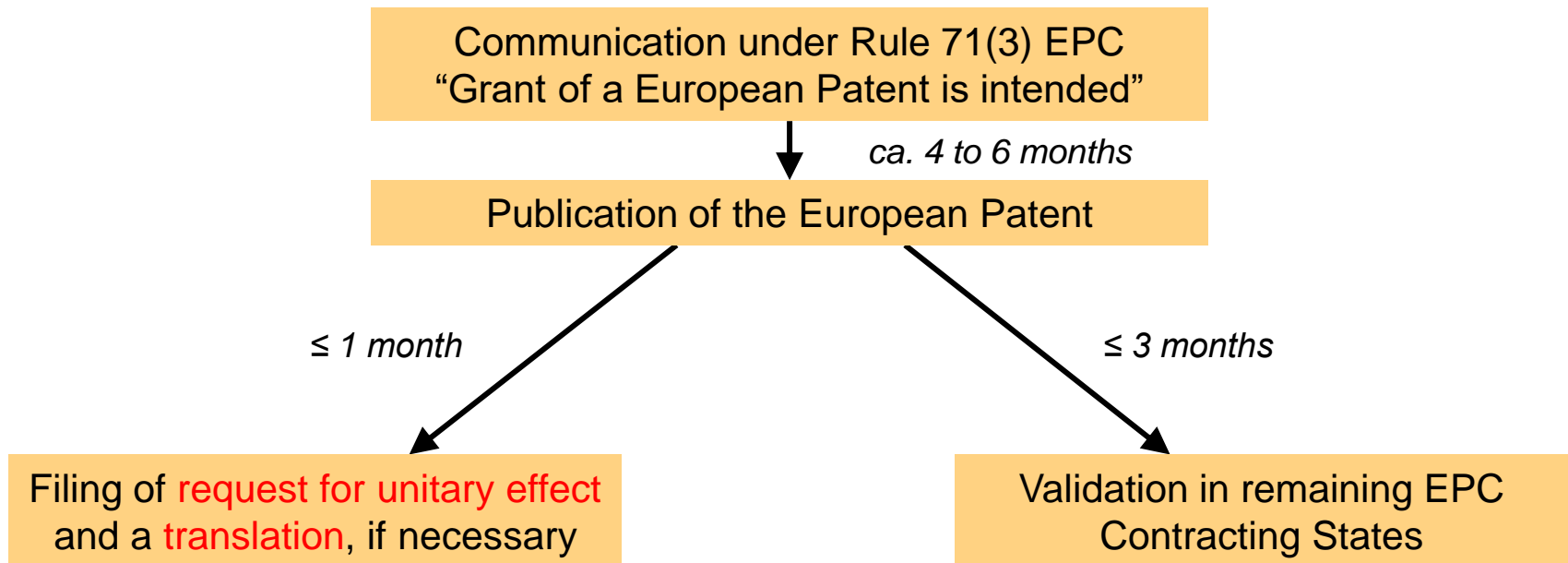
2. Unitary Patent

Coverage of the Unitary Effect of a Unitary Patent



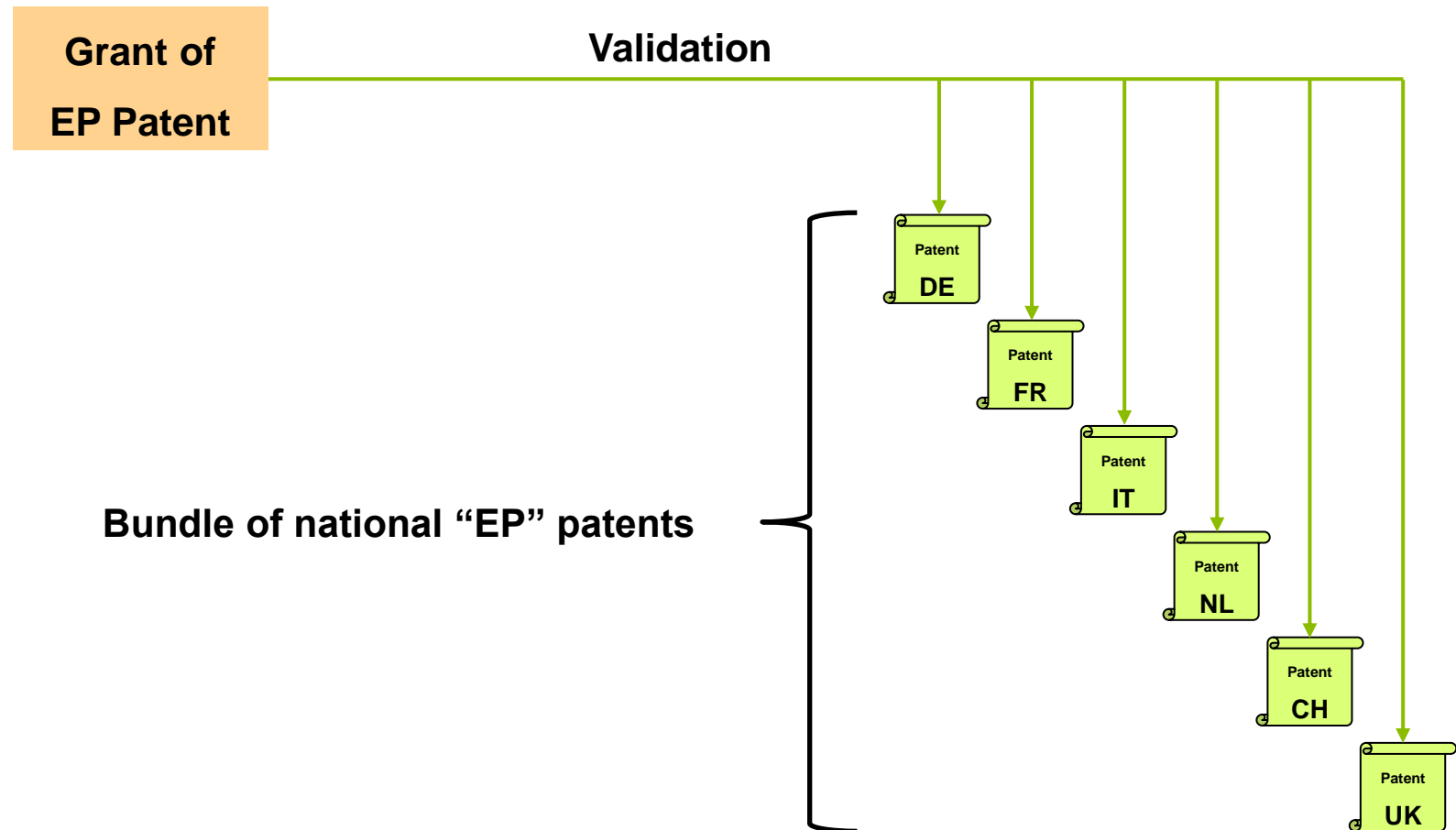
2. Unitary Patent

How to obtain a Unitary Patent?



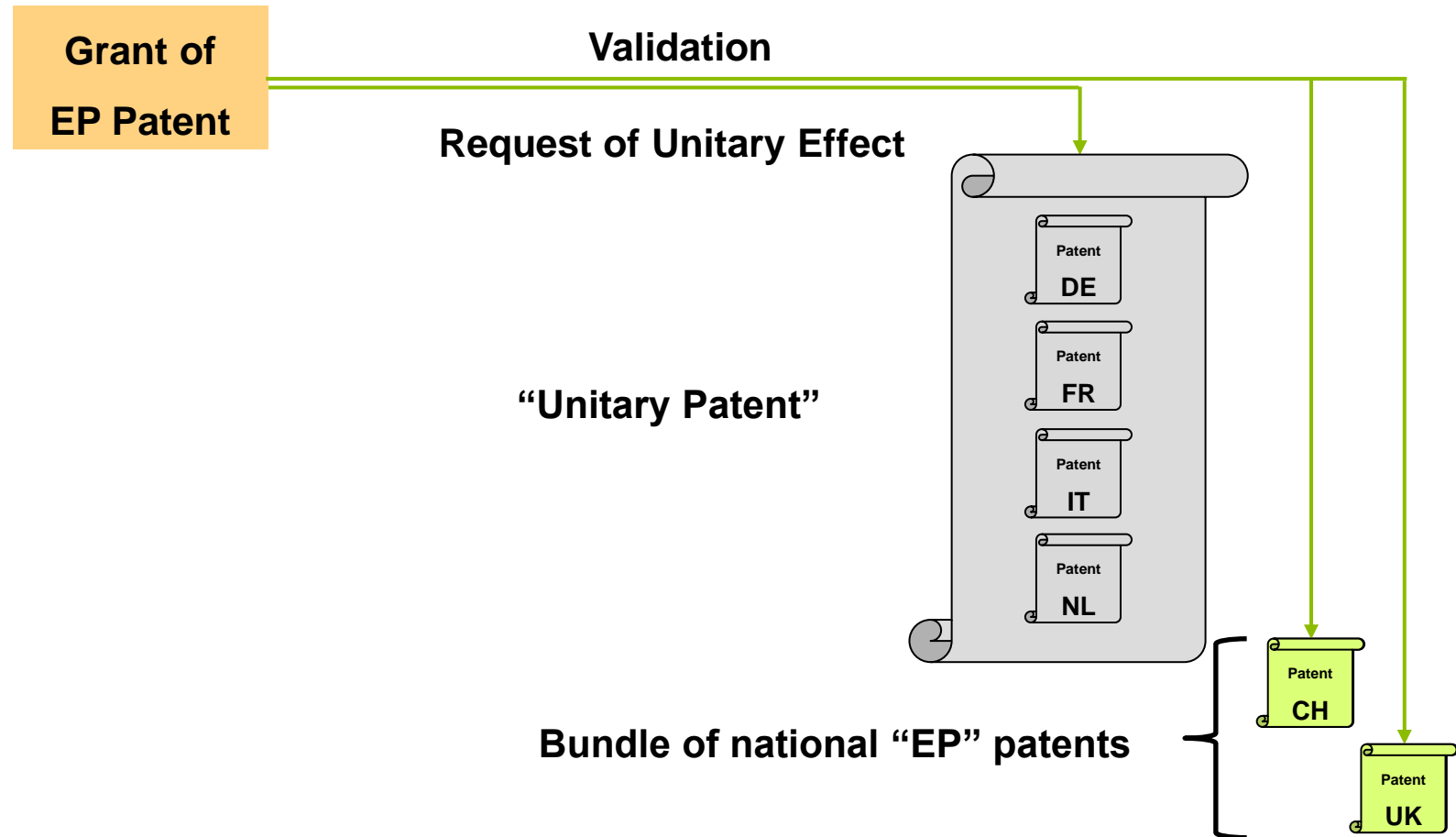
2. Unitary Patent

“Classical” validation of an EP patent



2. Unitary Patent

New post grant option “unitary effect”

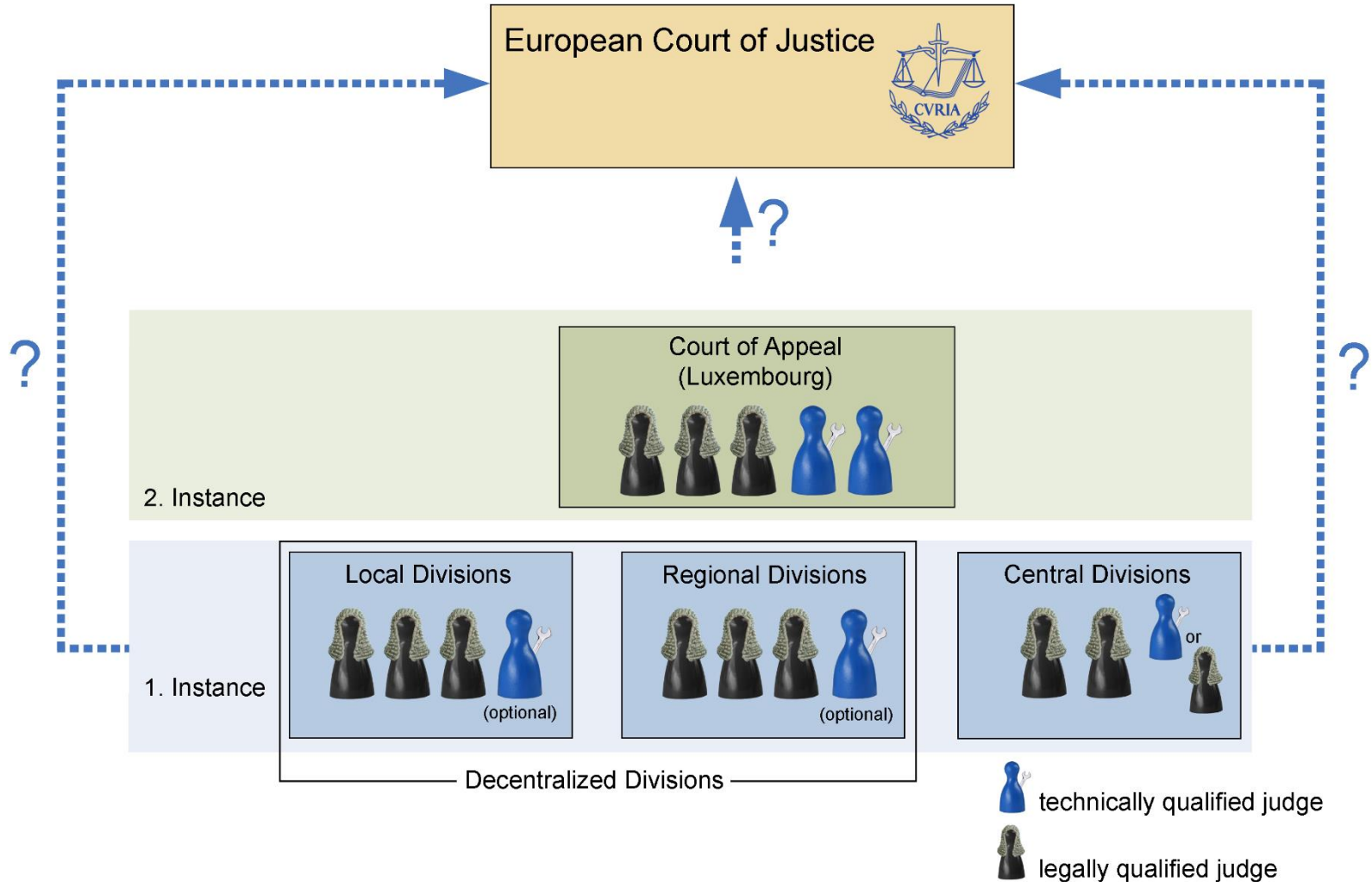




3. Unified Patent Court (UPC)

3. The Unified Patent Court

Basic Structure and Panel Composition of the UPC



3. The Unified Patent Court

UPC's jurisdiction and competence

Principle of omnipotent jurisdiction:

UPC will (eventually) have jurisdiction over both (classical) European patents and Unitary patents.

During a transitional period of 7 (+7) years,

- national courts are still available and
- possibility to opt out from the exclusive competence for (classical) European patents.

Note: After the transitional period, only filing of national applications may avoid the exclusive competence of the UPC.

3. The Unified Patent Court

UPC's jurisdiction and competence

Possible **nullification** of existing national EP bundle patents **in all the respective UPCA member states** with a **single action** before the UPC.

Example:

Revocation action before UPC vs EP patent validated (inter alia) in **Germany, France, Netherlands, Belgium and Italy**.

If successful, nullification of the EP patent for Germany, France, Netherlands, Belgium and Italy*.

To avoid this situation, proprietors of existing classical EP patents need to opt-out from the exclusive competence!

* Note that validations for **non-UPC member states** are **not** affected by a UPC revocation action



4. Start of UP/UPC system?

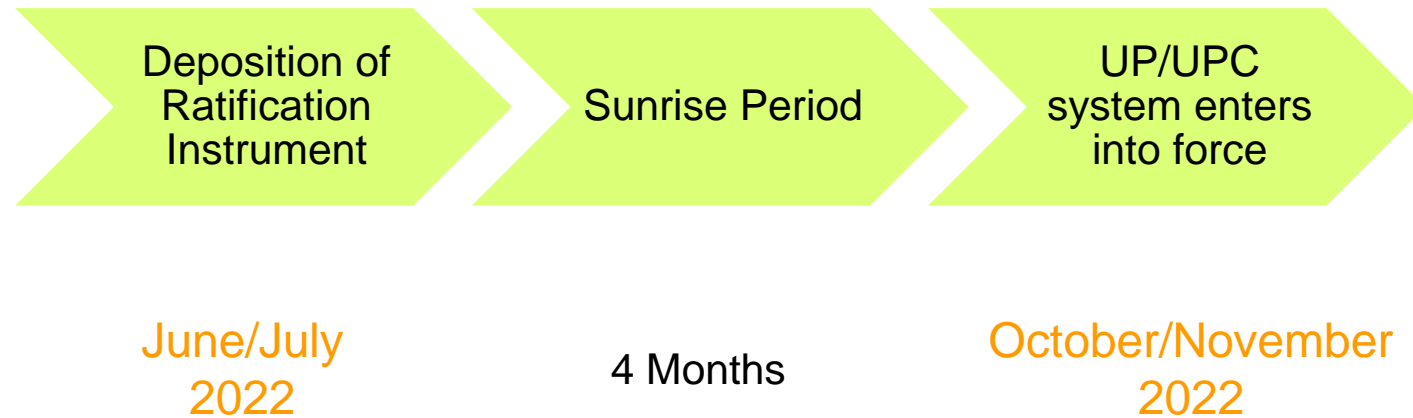
4. Start of UP/UPC system?

Ready to go but not ready to work

- Only **deposition of the German instrument** of ratification is missing for the UP/UPC system to start
- **Germany acts as “Gatekeeper”** (i.e. deliberately delays deposition of the instrument of ratification which starts the 4 month sunrise period)

4. Start of UP/UPC system?

Planning by the German Ministry of Justice:





5. Unitary Patent - yes or no?

5. Unitary patent – yes or no?

Key considerations for requesting a Unitary Patent

- Costs vs coverage
- No selective control of renewal fees by abandoning bundle patents (validations)
- Easier patent portfolio management
- Vulnerability to central revocation



5. Unitary patent – yes or no?

Rule of Thumb:

Yes if

- EU wide patent protection is needed,
and/or
- Central revocation by the UPC is acceptable

No if

- Patent protection is needed only in **up to four** EPC member states,
and/or
- Central revocation by the UPC is **not** acceptable



6. Timing of pending grant procedures



6. Timing of pending grant procedures

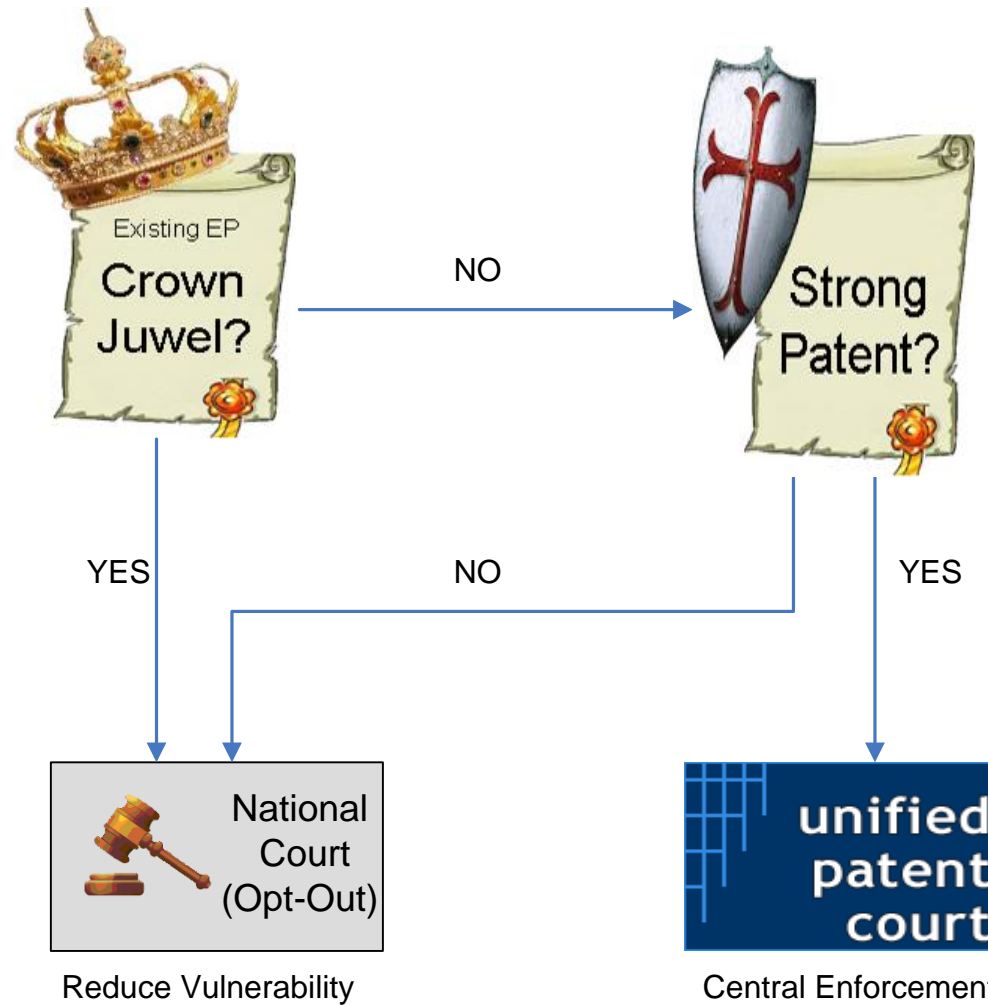
Delaying grant for obtaining a Unitary Patent

- Requests for a unitary patent are **only** possibly **once** the UP/UPC entered into force. However, grant of EP applications could be **delayed** until the start of the UP/UPC system.
- **After** deposition of the German ratification instrument:
 - Request suspension of grant in response to the R 71 (3)
 - Early Request for unitary effect
- **Before** deposition of the German ratification instrument:
 - Consider employing strategies to defer grant by not declaring consent to pending R 71 (3) communication and the like



7. When and how to Opt-out?

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7. When and how to Opt-out?

Key Points of Opt-out

Opt-out requests are possible **during the transitional period unless** an action has already been brought before the UPC (e.g. DNI or revocation action).

No opt-out for unitary patents

Possibility to **opt back in (i.e. to withdraw from opt out)** unless an action has already been brought before a national court

Effective **only** upon registration with UPC's Registry

Possible **already during sunrise period** via online filing of an electronic form using the UPC's electronic case management system

No official fee - but significant **administrative burden**



7. When and how to Opt-out?

Draft for Opt-out form

OPT-OUT DOCUMENT TEMPLATE

(Note: Rule 5.3 requires the following information and declaration in respect of each patent/application/SPC listed below.)

EUROPEAN PATENT APPLICATION DETAILS (RoP 5.3)

(Note: This section must be repeated for each application the subject of this Application to opt out.)

PUBLICATION NUMBER of the European Patent Application []

Details of the applicant(s) for the patent
(Note: This "Details of the applicant(s)" section must be repeated for each applicant.)

Applicant: []
 Postal address: []
 Electronic address: []

EUROPEAN PATENT DETAILS (RoP 5.3)

(Note: This section must be repeated for each European patent the subject of this Application to opt out.)

PUBLICATION NUMBER of the European Patent []

Proprietor(s) of each EPC designation / EPC state in which the patent has been granted
(Note: The proprietor(s) section must be repeated for each proprietor of the patent)

Country abbreviation: []
 Proprietor: []
 Postal address: []
 Electronic address: []

Details of each granted SPC based upon each of the patents listed above (RoP 5.3(a)).
(Note: This section can be omitted if not applicable.)

Publication Number: []
 Country abbreviation: []
 SPC Number: []
 Holder: []
(Note: The Holder section must be repeated for each holder of the SPC)

Postal address: []
 Electronic address: []

Opt-out Document Template Page 1 of 2 11/05/2020

PERSON LODGING THIS APPLICATION TO OPT OUT (RoP 5.3(b))

Details of the person lodging this opt-out on behalf of each proprietor of each patent/application listed above and each holder of an SPC based on each such patent. (RoP 5.3(b)).

Name: []
 Company/Firm: []
 Postal address: []
 Electronic address: []
 Status:
(tick the applicable option)

Representative pursuant to Article 48 of the Agreement on a UPC
 User authorised to file this opt-out with a mandate
 Personal proprietor of each listed patent

DECLARATION (RoP 5.3(e))

The person lodging this opt-out must provide the following declaration:

I hereby declare that each proprietor of each patent/application listed above is entitled to be registered pursuant to RoP 8.5.

Date []
 Signature []

Opt-out Document Template Page 2 of 2 11/05/2020

7. When and how to Opt-out?

Authorization form for Opt-Out

Mandate for lodging an Application to opt out / to withdraw an opt-out / to correct an opt-out / to correct a withdrawal of an opt-out pursuant to Rule 5 of the UPC Rules of Procedure

This mandate is valid from [*date*] until [*date*].

List each patent/application number:

Patent / Application number	Proprietor/Applicant pursuant to Rule 8.5

List each granted SPC:

SPC ID	Country	Holders	Patent number

The following person is authorised to lodge an Application to

- opt out
- withdraw an opt-out
- correct an opt-out
- correct a withdrawal of an opt-out

in respect of the patents/applications/SPCs referred to above on behalf of the above mentioned proprietors/applicants/holders.

Authorised by:

Name,	Position	Signature	Date

RoPS Applications Mandate Template 1 Version 3 - 11/05/2020

7. When and how to Opt-out?

Important Specifics

Multiple proprietors of an European patent need to **commonly** opt-out.

Opt-out only effective when the “**true**” **proprietor** has registered the opt-out.

=> **Danger** of an **invalid** opt-out registration



8. To-Do-List for preparing to the UP/UPC system

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To-Dos for the upcoming Sunrise Period:

1. Evaluate general or at least case-wise Opt-Out!
Withdrawal of Opt-Out (“Opt-In”) is always possible, however only once.
2. Check whether your EP representative could handle opt-out requests effectively, in particular, when large numbers of patents need to be opt-out
3. Analyze your pending EP applications:
Go for the new Unitary patent or stay with the classical EP patent?
4. If your choice is a unitary patent, check in pending applications whether a Rule 71(3) Communication has been received. If yes, control the timing of the grant process to delay the grant until the UP/UPC starts.

Thank you for your attention!



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